

Application Serial No.: 09/392,254  
Reply to Office Action dated January 23, 2004

REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 17-19, 21-24, and 30-41 are presently active in this case, Claim 17 having been amended and Claims 30-41 having been added by way of the present Amendment.

The Applicants want to thank Examiner Nikolas Uhlir for the courtesies extended to Applicants' representative, Christopher Ward, during the personal interview conducted on April 9, 2004. The Applicants submit that the amendments to the claims set forth herein embody the issues discussed during the personal interview.

In the outstanding Official Action, Claims 17, 18, and 21-24 were rejected under 35 U.S.C. 102(b) as being anticipated by Kanematsu (JP 6-304973), or alternatively under 35 U.S.C. 103(a) as being unpatentable over Kanematsu. Claim 19 was rejected under 35 U.S.C. 103(a) as being unpatentable over Kanematsu in view of Hirofumi (JP 6-315961). For the reasons discussed below, the Applicants request the withdrawal of the art rejections.

In the Office Action, the Kanematsu reference is indicated as anticipating independent Claims 17 and 21. However, the Applicants note that a claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As will be demonstrated below, the Kanematsu reference clearly does not meet each and every limitation of the independent Claims 17 and 21. Furthermore, the Applicants submit that the basic requirements for establishing a *prima facie* case of obviousness as set forth in MPEP 2143 are not satisfied by the Kanematsu reference, since

the reference does teach or suggest all of the claim limitations and since there is no suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to arrive at the present invention.

Claim 17 recites a plastic molding comprising, among other features, all of a plurality of imperfect transfer portions that are formed so as to have a contour *disposed apart from an edge of the transfer surface*. Claim 21 of the present application recites a plastic molding comprising, among other features, an imperfect transfer portion formed in a portion other than the transfer surface, where the imperfect transfer portion is formed so as to have a contour *disposed apart from an edge of the transfer surface*, and *wherein the transfer surface is not in contact with any imperfect transfer portions*. (Support for these amendments can be found throughout the specification, including the drawings.) As will be discussed below, the Kanematsu reference does not disclose or suggest a plastic molding having the above features.

Regarding the anticipation rejection based upon the Kanematsu reference, the Official Action acknowledges that the Kanematsu reference does not expressly teach an imperfect transfer portion that has a contour disposed away from the edge of the transfer surface. (Page 4, lines 1-3.) The Official Action indicates that the Kanematsu reference teaches that sink marks do not form in the transfer surface (13) in section 31, however, a review of section 31 indicates that the sink marks are prevented from occurring in the resin portions (r). Section 31 does not state that sink marks are not formed in the transfer surface (13), but rather that sink marks are prevented from occurring in the resin portions (r), and that the result of this is that the transfer surfaces (13) can be transferred with high precision. Section 20 refers to the

“mirror-surface portion” being prevented from being influenced by the sink marks, rather than the transfer surface. Thus, the Kanematsu reference does not provide an express teaching of an imperfect transfer portion that has a contour disposed away from the edge of the transfer surface. Certainly, the Kanematsu reference does not teach a plastic molding where all of a plurality of imperfect transfer portions are formed so as to have a contour disposed apart from an edge of the transfer surface, as recited in Claim 17, or a plastic molding where the transfer surface is not in contact with any imperfect transfer portions, as recited in Claim 21. The Applicants submit that a conclusion that this feature is taught is mere speculation, and that the only motivation for making such a modification of the Kanematsu reference is the teachings of the present application.

The Applicants note the embodiments depicted in Figures 6 and 7 of the Kanematsu reference teach away from a configuration in which all imperfect transfer portions have a contour disposed away from the edge of the transfer surface, and teach away from a configuration in which the transfer surface is not in contact with any imperfect transfer portions. The embodiments of Figures 6 and 7 include ceramic plates or porous members (51) as the side surfaces of the mold. The ceramic plates (51) spread the sink mark over a wide area, which extends over the entire side surface of the mold to the edge of the transfer surfaces. Such embodiments teach away from the plastic moldings recited in Claims 17 and 21 of the present application, since such a configuration will produce imperfect transfer portions up to and including the edge of the transfer surface and thus the transfer surface will contain imperfect transfer portions.

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The Applicants, therefore, respectfully submit that the rejection is based on the improper application of hindsight considerations. It is well settled that it is impermissible simply to engage in hindsight reconstruction of the claimed invention, using Applicant's structure as a template and selecting elements from the references to fill in the gaps. *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). Recognizing, after the fact, that a modification of the prior art would provide an improvement or advantage, without suggestion thereof by the prior art, rather than dictating a conclusion of obviousness, is an indication of improper application of hindsight considerations. Simplicity and hindsight are not proper criteria for resolving obviousness. *In re Warner*, 397 F.2d 1011, 154 USPQ 173 (CCPA 1967).

Claims 18, 19, 22-24, and 30-32 are considered allowable for the reasons advanced for Claim 17 from which they depend. These claims are further considered allowable as they recite other features of the invention that are neither disclosed, taught, nor suggested by the applied references when those features are considered within the context of Claim 17.

Claims 33-35 are considered allowable for the reasons advanced for Claim 21 from which they depend. These claims are further considered allowable as they recite other features of the invention that are neither disclosed, taught, nor suggested by the applied references when those features are considered within the context of Claim 21.

Newly added Claims 36-41 believed to be allowable as they recite other features of the invention that are neither disclosed, taught, nor suggested by the applied references. For example, new Claim 36 recites a plastic molding comprising, among other features, a reference portion for setting the plastic molding that is provided on a side surface adjacent to

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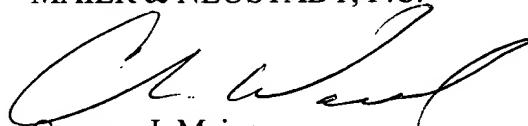
at least one transfer surface, and a pair of imperfect transfer portions that are provided on the side surface on opposite sides of the reference portion. Claim 39 recites a plastic molding comprising, among other features, a reference portion for setting the plastic molding that is provided on a side surface adjacent to the transfer surface, and a pair of imperfect transfer portions that are provided on the side surface on opposite sides of the reference portion.

Newly added Claims 30-41 are supported by the disclosure, for example, in Figures 6 and 8-11 and the corresponding descriptions thereof in the specification. No new matter has been entered.

Consequently, in view of the above discussion, it is respectfully submitted that the present application is in condition for formal allowance and an early and favorable reconsideration of this application is therefore requested.

Respectfully Submitted,

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